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09/819,899	03/29/2001	Jim Paul Haughwout	06975-144001 / Member Ser	5374

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/819,899

Applicant(s)

HAUGHWOUT, JIM PAUL

Examiner

Marissa Thein

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

Art Unit: 3625

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to because Figures 7A through 10 have reference numbers that are within the table making it hard to distinguish. Applicant is required to submit a formal correction of the noted defect. Applicant is required to submit drawing corrections promptly. Drawing objections may no longer be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 83 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the selecting code segment" has insufficient antecedent basis.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3625

**Claims 1, 3-21, 25-36, 38-51, 55-63, 65-78, and 82-89 are rejected under 35 U.S.C.102(e) as being anticipated by Patent Application Publication Pub. No. US 2002/0077130 to Owensby.**

Owensby discloses a method and system for providing targeted messages (sales pitch), such as audio commercial information or advertisements, to a subscriber (caller) of a wireless mobile communication service. The method and system for providing targeted messages to the subscriber includes the steps of: (a) compiling a first database of pre-selected messages to be targeted to the subscriber and predetermining criteria for choosing the messages to be targeted to the subscriber (automatically selecting a first sales pitch appropriated for the caller based upon the information accessed about the caller); (b) transmitting a wireless mobile communication comprising a call signal and Wireless Mobile Location data included with the call signal (receiving a call from a caller); (c) utilizing the predetermined criteria of the first database to choose a message from the plurality of pre-selected messages of the first database that is targeted to the subscriber on the based on the wireless mobile location of the terminal (accessing information about the caller gathered prior to the call); and (d) providing the targeted message to the subscriber (see at least paragraph 43). Furthermore, the system and method permit the subscriber to interactively respond to a message provided to the subscriber, or to an inquiry for additional information from the operator of the service or from the sponsor of the message. Preferably, the operator queries the subscriber at the conclusion of a message, at the conclusion of a group of messages or at the conclusion of the wireless mobile communication, to select one of several options and then

Art Unit: 3625

monitors the subscriber's response to the query. For example, the subscriber could request the operator to insert another message (second sales pitch) into the wireless mobile communication, to forward an audio, video or electronic data copy of the previously provided message to an electronic message input, storage and retrieval database (e.g., voice mail, e-mail, facsimile, etc.), or to establish a direct telecommunications or other data link with a representative of the sponsor of the message (commercial partner). The subscriber may respond to the operator's query and the operator may fulfill the subscriber's request immediately following a particular message, immediately following a group of messages or following the conclusion of the wireless mobile communication (e.g., in the form of a "call-back" from a representative). (See paragraph 16) The messages are further targeted to the subscriber on the basis of: predetermined Subscriber Profile Data pertaining to the subscriber previously provided to the subscriber which is stored in an electronic database; Historical Response Data relating to the responses made to the targeted messages which is stored in an electronic database (historical information based on responses made by the caller in response to past sales pitch offers); and Historical Response Data relating to the historical movement patterns of the subscriber which is stored in an electronic database (historical information based on past misbehavior of the caller) (see at least paragraph 2). The Subscriber Profile Data includes demographic and personal preference data (e.g. name, address, and home telephone number) which pertain to the subscriber that is collected from the subscriber at the time the subscriber registers with the operator of the communication services, and is stored in an electronic data, input,

Art Unit: 3625

storage, and retrieval device and updated at regular intervals (wherein information accessed about the caller comprises information regarding current enrollment by the caller in products or services offered by a commercial partner). The message can also be further targeted to the subscriber based on the geographical location of the subscriber (accessing information about the caller includes accessing a geographic residence of the caller) (see paragraph 11). Furthermore, the system discloses Ad insert Records which computes the Subscriber Billing Subsidy to be credited to the subscriber account, wherein the Ad Insert Records is forwarded to the Operator Billing System to apply the Subscriber Billing Subsidy to the appropriate subscriber (satisfactory credit status) (see paragraph 52). The system also includes an Ad Target Data, which is a database management program that inputs and stores messages the meet a criteria for choosing (relationship between products and services of commercial partners). Moreover, the system includes a Call Routine Generator which embodies an algorithm setting out the rules for assigning targeted advertisements to call in view of the Ad Selection Code and the Ad Target Data. The algorithm of the Call Routine Generator is a multiple step process that begins with a large pool of advertisements and narrows the pool until only advertisement with protocols that are satisfied by the Ad Selection Code remain (automatically determining a pool of available sales pitches). The Call Routine Generator may generate a secondary pool consisting of rejected advertisements. (See at least paragraph 64-71).

***Claim Rejections - 35 USC § 103***

Art Unit: 3625

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2, 4-5, 37, 39-40, 64, and 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby.**

Owensby discloses substantially the claimed invention, however, it does not disclose that the operator is specifically, human. Although the reference is silent to the particular operator, it would have been obvious to one of ordinary skill in the art to have provided the operator already disclosed by Owensby to have been human, such particular operator would have been recognized by the skilled artisan as being one of numerous operators. Moreover, applicant has not persuasively demonstrated that the particular operator is critical or is anything more than one of the numerous operators that the skilled artisan would have found suitable for the purpose taught by Owensby. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a human as an operator, such as the operator taught in Owensby, to provide assistance to a caller.

**Claims 22-24, 35, 52-54, 62, 79-81, and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby as applied to claims 1, 36 and 63 above, and further in view of U.S. Paten No. 5,937,037 to Kamel et al.**

Owensby discloses substantially the claimed invention, however, it does not disclose the commercial partner providing a second sales pitch to the caller and a

Art Unit: 3625

relationship between products and services of one commercial partner to sales pitches corresponding to products and services of another commercial partner. Kamel, on the other hand, teaches a system and method which are configured to support a wide range of functionality to meet the message delivery (sales pitch) specifications provided by third party sponsors (commercial partner). These functionalities include message targeting, conditional message delivery, message grouping and sequencing, message frequency, interactivity, information capture, and updates (second sale pitch). (See at least col. 11, line 34 – col. 13, line 53). Furthermore, Kamel teaches a message bank which contain promotional messages, such as advertisements, to be delivered to subscribed calling parties and/or called parties. The promotional messages are provided by third party sponsors (commercial partners). The message bank has a plurality of electronic queues for storing data indicative of promotional messages and receives, stores and maintains a copy of all messages and their associated targeting parameters for all active campaigns. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and system of Owensby, to include the second sales pitch of the commercial partner, as taught by Kamel, in order to provide a targeted message based on a caller's response.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



Art Unit: 3625

U.S. Patent No. 5,933,811 to Angles et al. discloses a system and method for delivering customized electronic advertisements in an interactive communication system.

U.S. Patent No. 5,963,635 to Szlam et al. discloses an automated customer service system, which accommodates both inbound and outbound communications that uses a variety of media.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on Monday-Friday 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mtot  
February 23, 2003

  
WYNN W. COGGINS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600